



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,098	07/18/2007	Anke Stabenau	66188NAT(50964)	6371
21874 7590 04/25/2011 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
LOVE, TREVOR M				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
04/25/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,098

Applicant(s)

STABENAU ET AL.

Examiner

TREVOR LOVE

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 24, 26 and 29-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23, 25, 27, 28 and 38-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-52 are pending.

Claims 40-52 are newly added.

Claims 1-22, 24, 26, and 29-37 are withdrawn.

Claims 22, 25, 27, 28, and 38-52 are currently under consideration with regard to election/restriction.

Election/Restriction is currently being necessitated by Applicant's amendments to the instant claims and the addition of 13 new claims. It is noted that Applicant's response directed to the Non-Final Rejection mailed 09/27/2010 will be addressed in the next Office Action.

It is further noted that the newly added claims are replete with indefinite terminology. For example "preferably" and "like".

Election/Restrictions

This application contains claims directed to the following patentably distinct species:

Species Election 1 of 3

Applicant is required to elect a single, or specific combination of, species of polymer from those disclosed in claim 42. The species are as follows:

- a. Applicant may elect a swellable polymer.
- b. Applicant may elect a dissolvable polymer.
- c. Applicant may elect an erodable polymer.

- d. Applicant may elect a specific combination of the above identified polymers.

The classes of polymers are distinct since the classes identify that the polymers have separate and distinct properties such that a search for a swellable polymer would not be coextensive, and would not necessarily even be overlapping with a search for an erodible polymer. It is noted that the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter.

Species Election 2 of 3

Applicant is required to elect a single, or specific combination of, species of gel forming material from those disclosed in claims 43 and 44. The species are as follows:

- a. A single, or specific combination of, species of gel forming material from those disclosed in claim 43.

The species of gel-forming materials are distinct since the species identified cover a many divergent types of gel-material. A search for any one species from those disclosed in claim 43 would not necessarily be coextensive with a search for any of the other species of claim 43. It is noted that the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter.

Species Election 3 of 3

Applicant is required to elect a single species of active ingredient from those disclosed in claims 55 and 56. The species are as follows:

- a. Applicant may any single species from those disclosed in claims 55 or 56.

The species of active ingredients in claims 55 and 56 are distinct since a search for one of the species, such as a proteinase inhibitor, would not necessarily be coextensive with a search for another species, such as DNA. It is noted that the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter.

These species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 23 is generic.

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:

- the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter.
- the species or groupings of patentably indistinct species require a different field of search.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or a grouping of patentably indistinct species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species or grouping of patentably indistinct species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.

Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

A telephone call was made to Jeffery Hsi on 04/15/2011 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR LOVE whose telephone number is (571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/SHARMILA G. LANDAU/

Supervisory Patent Examiner, Art Unit 1611